



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,133	09/26/2003	Stephen A. Ewald	19645.1	6111

49358 7590 08/01/2006

CARLTON FIELDS, PA
1201 WEST PEACHTREE STREET
3000 ONE ATLANTIC CENTER
ATLANTA, GA 30309

EXAMINER

SMITH, JEFFREY A

ART UNIT PAPER NUMBER

3625

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/672,133

Applicant(s)

EWALD, STEPHEN A.

Examiner

Jeffrey A. Smith

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2006 and 13 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after a Decision by the Board of Patent Appeals and Interferences (hereafter: the "Board"), but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submissions filed on June 23, 2006 and July 13, 2006 have been entered.

Response to Submissions

The submissions filed on June 23, 2006 and July 13, 2006 have been entered and considered.

Claims 1-19 are pending.

An action on the merits of the claims follows.

The Submission filed June 23, 2006

The Declaration of Walter E. Thain, Jr. under 37 CFR 1.132 filed June 23, 2006 (hereafter: the "Declaration") is insufficient to overcome the rejection of claims 1-13, and 15-19 based upon 35 USC 102(e) and the rejection of claim 14 based upon 35 USC 103(a) as affirmed by the Board in the "Decision on Appeal" mailed April 26, 2006 (hereafter: the "Decision").

As an initial matter, in the Remarks filed June 23, 2006 (hereafter: the "June 23 Remarks"), Applicant traverses the rejections of claims 1-19 on the grounds that Kesling et al. does not disclose the element of the "purchase request" (June 23 Remarks at page 2, second paragraph) and relies upon the Declaration as evidence that "[the Kesling et al.] disclosure would not have enabled one of ordinary skill in the art to create a broadcast receiver-generated purchase request" (June 23 Remarks at paragraph bridging pages 1 and 2). The Declaration is presented in an effort to obviate a failure in providing evidence in support of Applicant's argument--previously before the Board--that the Kesling et al. reference lacks technical detail and that the disclosure would not have enabled one of ordinary skill in the art to create a broadcast receiver-generated purchase request.

As stated by the Board in its Decision:

Art Unit: 3625

"The appellant argues that the only technical detail disclosed by Kesling is that the broadcast receiver includes a high power wireless transceiver and can function as a conventional text pager (§ 0066), and that this disclosure would not have enabled one of ordinary skill in the art to create a broadcast receiver-generated purchase request (brief, page 7; reply brief, page 2). The appellant has not provided evidence in support of that argument, and arguments of counsel cannot take the place of evidence. See *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. 1984); *In re Payne*, 606 F.2d 303, 203 USPQ 256 (CCPA 1979); *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978); *In re Pearson*, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974). Moreover, the similar lack of technical detail in the appellant's specification indicates that one of ordinary skill in the art could carry out a radio-generated purchase based upon the appellant's disclosure at the time of the appellant's invention, that person could do the same given Kesling's disclosure."

The Examiner notes that Applicant's traversal on the ground that Kesling et al. does not disclose the element of the "purchase request" is an issue separate from the issue of whether or not the Kesling et al. reference provides an enabling disclosure. The Board has taken up these issues separately. The Board undertakes a first analysis to determine whether Kesling et al. has disclosed a "purchase request" (Decision at page 3, first paragraph) before moving to undertake a second analysis to determine whether the Kesling et al. disclosure has enabled one of ordinary skill in the art to create a broadcast receiver-generated purchase request (Decision at the paragraph bridging pages 3 and 4).

Art Unit: 3625

At this point it is critical that an analysis of the phrase "purchase request" be revisited. The Examiner looks to the specification to determine the scope of such phrase. A reading of the specification reveals the following:

"Fig. 3 is a flowchart of the process executing on the broadcast receiver 14 to purchase goods or services linked with the received broadcast media. The broadcast receiver 14 makes a determination as to whether the user has requested to purchase a good or service, as shown at decision 70. If no purchase has been indicated at decision 70, then the process reiterates such that the broadcast receiver 70 is in a wait state for user input. Otherwise, if the user requests to purchase at decision 70 (i.e. pressed button 15), a determination is then made as to whether identification data is present in the broadcast data stream such that the good or service desired to be purchased can be identified, as shown at decision 72. If there is no identification data present at decision 72, then an error is output to the user, as shown at step 74, and then process returns to decision 70." (paragraph 0026 at page 8).

"As long as the broadcast media includes identification data such that the broadcast receiver can identify the good or service desired to be purchased, the person can simply indicate a desire to purchase, such as pressing button 15, and the broadcast receiver 14 will inform the person if the good or service is not purchasable using the system 10." (paragraph 0025 at page 7).

"An example is a data frame at the beginning of a song that the receiver 14 records so that if the song is selected for purchase during its broadcast, the receiver 14 will have the identification data readily available. Thus, upon the next song being played, the new frame is loaded, or if no frame is present, the receiver does not attempt purchase of the song even if requested." (paragraph 0022 at page 6).

"In this embodiment, the receiver 14 includes an indicator button 15 or other means so that the person can simply indicate the desire to purchase a good or service while

Art Unit: 3625

that service is advertised in the broadcast media. As an example, if a listener hears a song played on the radio, he or she presses the button 15 to purchase the album that contains that song. The broadcast receiver 14 will inform the person if purchase is not available through an audible and/or visual alert after pressing the button 15." (paragraph 0018 at pages 4-5).

From the passages cited above, it is clear that a "purchase request" is merely an indication that a person wishes or desires to initiate a purchase transaction for a good or service. A "purchase request" is one step in completing a purchase transaction, but does not include within its scope all of the steps identified by Mr. Thain as being required in a purchase transaction (see Declaration at item 5). This is clear from the specification (particularly the passages cited above) which indicates that a person may make a request to purchase a good or service, or otherwise indicate a desire to purchase a good or service, yet that request or desire may never lead to a completion of a purchase transaction for the good or service (e.g. when no identification data of the desired good or service is present, when the broadcast media identification data for the desired good or service is unidentifiable, when no data frame for the desired good or service is loaded, or when purchase of the desired good or service is not available).

Art Unit: 3625

With the scope of the phrase "purchase request" in mind, and returning to the Declaration, the Examiner notes that none of the statements of Mr. Thain, Jr. support Applicant's argument that the element of the "purchase request" is not disclosed by Kesling et al. To the contrary, the Declaration supports the conclusion of the Board: that the element of the "purchase request" is, indeed, disclosed. To this end, Mr. Thain, Jr. states that "[c]onsidering the eight steps of a typical electronic purchase transaction, one sees that when a listener (buyer) presses button 1220 in radio 20, the system as described by Kesling can readily perform steps 1, 2, 3, and 4 immediately" (Declaration at item 14). A review of steps 1, 2, 3, and 4 at item 5 of the Declaration reveals an activity considered to be fully analogous to the "purchase request" described in the instant specification. Step "i" at item 5 identifies the activity of a buyer indicating to a seller that he wishes to start a purchase transaction. In the parlance of the instant application, this activity translates to "a person indicating a wish or a desire to initiate a purchase transaction for a good or service" or otherwise making a "purchase request" for a good or service. Accordingly, the Examiner is not persuaded by either argument or evidence that Kesling et al. fails to disclose the element of the "purchase request".

Art Unit: 3625

With the scope of the phrase "purchase request" in mind, and again returning to the Declaration, the Examiner notes that the Declaration is not effective in supporting Applicant's argument that the disclosure of Kesling would not have enabled one of ordinary skill in the art to create a broadcast receiver-generated purchase request (the argument presented before the Board and again in the June 23 Remarks). Although the Declaration presents evidence in support of a proposition that "pressing button 1220 does not enable a complete purchase transaction in the system described by Kesling, such evidence fails to support a conclusion that the Kesling et al. disclosure would not have enabled one of ordinary skill in the art to create a broadcast receiver-generated purchase request. Mr. Thain, Jr. states that "one sees that when a listener (buyer) presses button 1220 in radio 20, the system as described by Kesling can readily perform steps 1, 2, 3, and 4 immediately" (Declaration at item 14). Mr. Thain, Jr. also states that such steps are typical in a retail store purchase transaction and that the same steps are required in an electronic purchase transaction (Declaration at item 5). There is no apparent contention by Mr. Thain, Jr. that the Kesling et al. disclosure is not enabling for one of ordinary skill in the art to create a

Art Unit: 3625

broadcast receiver-generated purchase request (i.e. a step identified above as being analogous to step "i" in item 5).

Further, a comparison of the Kesling et al. disclosure and the disclosure of the instant invention reveals a similar level of technical detail between the disclosures. Such similar level of technical detail supports a finding that the Kesling et al disclosure enables one of ordinary skill in the art to create a broadcast receiver-generated purchase request in a manner not unlike the instant disclosure. Accordingly, it can be assumed that anyone desiring to carry out the creation of a broadcast receiver-generated purchase request would know the of the equipment and techniques to be used. *In re Epstein*, 31 USPQ2d 1817 (CAFC 1994).

Finally, it is noted that the Declaration moves beyond the scope of the phrase "purchase request" in order to support a conclusion that "pressing button 1220 does not enable a complete purchase transaction in the system described by Kesling". Initially, it is observed that this conclusion is prefaced on the proposition that the Kesling et al. invention (versus the Kesling disclosure) lacks utility (versus lacks enablement) for the purpose of completing a purchase transaction. The Examiner acknowledges that the issues related to utility and enablement often become commingled, however, in the instant case the

Art Unit: 3625

Declaration is presented in order to support the argument that the Kesling et al. disclosure would not have enabled one of ordinary skill in the art to create a broadcast receiver-generated purchase request, not that the Kesling et al. invention lacks utility in providing a completed purchase transaction. Even so, consideration has been given to the statements of Mr. Thain, Jr. which represent that "[a]n electronic communication system itself, including the one described in Kesling, is not capable of the high-level processing needed to facilitate complex actions such as processing the payment information exchanged in a purchase transaction". Such representation, absent any objective evidence that the invention of Kesling lacks actual utility in operating as disclosed, is not persuasive. Accordingly, there is no persuasive reason to believe that the Kesling et al. disclosure is not enabling due to a description of an invention that is not capable of operating as disclosed. Moreover, the Board has stated that not only is the Kesling et al. disclosure enabling for the purposes of creating a broadcast receiver-generated purchase request, but further that the Kesling et al. disclosure is enabling for the purposes of providing the technical detail necessary for one of ordinary skill in the art to actually carry out a radio-generated purchase (Decision at

Art Unit: 3625

paragraph bridging pages 3 and 4). There is nothing in the Declaration that offers evidence that one of ordinary skill in the art would not have known of the equipment and techniques to be used in carrying out the invention of Kesling et al.

The Submission filed July 13, 2006

The Remarks filed July 13, 2006 (hereafter: the "July 13 Remarks") are not persuasive.

Applicant remarks that "[The] addition of the back-end purchasing system [of the Napster[®] music download service to pay for and download songs to the receiver] supports Applicant's continued argument that the primary reference used to reject the present application, Kesling, et al. (US Publication No. 2002/0132575), does not enable a 'purchase request' as is claimed in the present application" (July 13 Remarks at page 1). Applicant further remarks that "Kesling is assigned to 'XM Satellite Radio'" that "the Pioneer Inno described in the User Guide is similar to the type of satellite receiver described by Kesling" (July 13 Remarks at page 2). Applicant concludes that "[t]he Users Guide shows that Dr. Thain is correct; a back end purchasing system must be added to a device such as one specified in Kesling in order to complete a purchase transaction" (July 13 Remarks at page 2) and that "[t]he User

Art Unit: 3625

Guide clearly illustrates that the stand-alone satellite receiver of Kesling must have further modification in order to complete a purchase transaction, in direct support of this assertion by Dr. Thain, and the receiver in Kesling therefore is not enabled for a 'purchase request' as asserted by the Patent Office" (July 13, 2006).

The Examiner first notes that the July 13 Remarks rely upon an analysis of a supposed specific configuration used by "XM Satellite Radio" (e.g. one which employs a portable "Pioneer Inno" device for receiving "XM Satellite Radio" and the Napster[®] music download service to pay for and download songs to the receiver) which Applicant correlates to the invention disclosed by Kesling et al. Applicant's analysis concludes, apparently, that since this specific configuration was identified in a User Guide published only as of 2006, and that since this specific configuration is not disclosed by the Kesling et al. reference, then the Kesling et al. reference necessarily lacks enablement for a "purchase request".

The Examiner believes that there is nothing presented in the July 13 Remarks which demonstrate that the Kesling et al. reference is not enabling for a "purchase request". Again, the Examiner interpretation of the phrase "purchase request" should be noted above. Moreover, enablement does not require that a

Art Unit: 3625

reference contemplate or foresee every conceivable configuration which may result from an actual reduction to practice of the disclosed invention. It is merely necessary that the public was in possession of the claimed invention before the date of invention. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his [or her] own knowledge to make the claimed invention." *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed.Cir. 1985). Again, in the instant case, the Board has stated that not only is the Kesling et al. disclosure enabling for the purposes of creating a broadcast receiver-generated purchase request, but further that the Kesling et al. disclosure is enabling for the purposes of providing the technical detail necessary for one of ordinary skill in the art to actually carry out a radio-generated purchase (Decision at paragraph bridging pages 3 and 4). There is nothing in the Declaration or in the Submission filed July 13, 2006 that offers evidence that one of ordinary skill in the art would not have known of the equipment and techniques to be used in carrying out the invention of Kesling et al. or that one of ordinary skill in the art was not in possession of the claimed invention before the date of invention to the degree that the skilled artisan could not have combined the description of the Kesling et al.

Art Unit: 3625

invention with his or her own knowledge to make the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13, and 15-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Kesling et al. (US 2002/0132575 A1).

Kesling et al. discloses a method for purchasing goods and services linked with broadcast media (par. 0039 and Figs. 1-3).

The method comprises receiving at at least one broadcast receiver a broadcast media including information relating to goods and services that can be purchased by persons receiving the media; selectively recording purchase data at the broadcast receiver for a good and service that a person purchases relating to the broadcast media; sending the purchase data from the broadcast receiver to at least one server; receiving the purchase data at the at least one server; and verifying the

Art Unit: 3625

purchase data from the broadcast receiver at the at least one server.

Kesling et al. references U.S. application serial number 09461,699 and incorporates such application by reference. See Kesling et al. at paragraphs [0007]-[0010]. Accordingly, the disclosure of such application forms part of the Kesling et al. disclosure as of the date of the incorporation by Kesling et al.

Kesling et al. builds upon the system and method disclosed by '699. The '699 disclosure states that "the receiver is adapted to receive an input from the user by which the user is able to signal an interest in purchasing a selection of music or data being played and/or displayed" ('699 at page 2, last line-page 3, line 2). Accordingly, claims 1, 9, 12 (as amended to recite "each receiver further selectively receiving a purchase request and recording purchase data for goods and services that a person purchases relating to the broadcast media" (claim 1, for example, and similar language in claims 9 and 12), is anticipated by Kesling et al.

Regarding claim 3: the purchase data may be transmitted at a predetermined location (par. 0043).

Regarding claims 5 and 6, respectively: Kesling discloses that the broadcast media may be an advertisement (information about the purchase of a particular good or service) or a song (no information about the purchase of a such song).

Regarding claims 7 and 8, respectively: the broadcast receiver may comprise either a single device (par. 0041) or an "intermediate transfer device" may be additionally employed as a purchase selection device (par. 0042).

Art Unit: 3625

Applicant's attention is directed to the Kesling et al. disclosure regarding "low" and "high" power wireless transmitters (600 and 700, respectively).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kesling et al. (US 2002/0132575 A1) in view of Official Notice regarding secure communication channels.

Kesling et al. does not disclose a secure communication channel. However, it is notoriously well-known to employ secure communication channels when endeavoring to conduct transactions of the type disclosed by Kesling. One of ordinary skill in the art would have modified the Kesling method to have included sending purchase data via a secure channel in order that confidential information relative to the customer or the customer's account is not readily intercepted.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Minushkin (WO 01/57757 A1) discloses system and method for obtaining impulse transaction data.

Christensen et al. (U.S. Patent No. 6,957,041 B2) discloses a system and method for ordering and delivering media content.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action

Art Unit: 3625

is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is (571) 272-6763. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert M. Pond can be reached on 571-272-6760. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey A. Smith
Primary Examiner
Art Unit 3625

jas